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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,086	03/02/2001	Kenichi Yoshikawa	SPO-582	4655

7590 09/22/2003

Sherman & Shalloway  
413 North Washington Street  
Alexandria, VA 22314

EXAMINER
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ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/22/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/719,086

Applicant(s)

YOSHIKAWA ET AL.

Examiner

Tatyana Zalukaeva

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_                      6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 3, 2003 has been entered.

2. Claims 1, 7, 12, 19 are amended, claims 26-18 are cancelled.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-24 stand rejected under 35 U.S.C. 102(b) as being anticipated by or in alternative as obvious over WO 91/16376.

WO'376 discloses a **packaging film** with good clinging properties comprising a **terpolymer**:

- of at least 50% of ethylene,
- 2-20% by weight of an unsaturated (meth) acrylic acid, and

- 2-20% of a moiety derived from at least one alkyl acrylate, alkyl methacrylate and mixtures thereof, wherein alkyl radical contains 2-12 carbon atoms (see page 3, lines 25-34).

This expressly meets not only the limitations on the nature of comonomers, but also clearly anticipates their relative amounts in a copolymer, as per instant claims 1-5

- The low level of sorbitan fatty acid ester can be added to improve antifogging properties (see page 4, line 3 and page 7, lines 9-19). Antifogging additive is present in a composition (page 6, line 27). This expressly meets the limitations of the instant claim 6.

WO'376 further teaches that the acid groups of the polymer of the acid containing moiety are neutralized (ionized) 0-10% by at least one metal ion (see page 3, line 35 and page 4, line 1). Suitable metals are metals of Group I, II and III, out of which Zinc and Sodium (alkali metal) are most preferable. (see page 6, lines 1-13). This expressly meets the limitations of claims 7-18.

With regard to the stretching properties of the films, since the films of WO'376 are identical in their chemical make-up to the instantly claimed films and are made by essentially the same method as instantly claimed films, such properties inherently present in the films of WO'376. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties **are inseparable**. Therefore if the prior art teaches the identical chemical structure, the

Art Unit: 1713

properties and characteristics applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705,709,15 USPQ2d 1655,1658 (Fed. Cir. 1990).

The above rejections were also made in the sense of In re Fitzgerald or In re Spada, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art. The properties not disclosed in the cited reference are believed to be inherent for the compositions identical to those instantly claimed.

It is noted that the above claims 19-24 are **product-by-process** claims, wherein the limitation of the process not disclosed in WO'376 is that the film is "effected according to the T-die method". However, in terms of the chemical components and their amounts in a terpolymer the films of WO'376 and the instant claims are identical, which was addressed in the 102 (b) rejection. Furthermore, films of WO'376 are prepared by an extrusion method (page 7, lines 33-35), the non-specified difference is the shape of die (which is a limitation of apparatus for extrusion). Applicants are reminded that patentability of the product is based on the product formed –not by method by which it was produced, In re Thorpe, 777 F 2d 695, 227, USPQ 964 (Fed. Cir 1985)

Furthermore, because of the nature of product-by process claims, the Examiner cannot ordinarily focus on the precise difference between the claimed product and the disclosed product. It is then Applicants' burden to prove that an unobvious difference exists. See In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983).

Art Unit: 1713

See also footnote 11 O.G. Notice 1162 59-61, wherein a 35 USC 102/103 rejection is authorized in the case of product-by-process claims because the exact identity of the claimed product or the prior art product cannot be determined by the Examiner.

*In re Brown*, 173 USPQ 685 (CCPA 1972), the Court of Customs and Patent Appeals (CCPA) explicitly approved the 102/103 rejection of a product-by-process claim over a reference which showed a product which appeared to be identical or only slightly different from the claimed product.

### ***Response to Arguments***

5. Applicant's arguments filed September 3, 2003 have been fully considered but they are not persuasive. The crux of Applicants' arguments appears to hinge on the **statement that "while the chemical make-up may be similar, the presently claimed compositions are distinguishable in structure and molecular arrangement from those of the prior art"**

This is absolutely not persuasive for at least two reasons:

a) there is absolutely no indication and/or guidance in the instant specification, in fact no mentioning at all about any specifics of the structure and/or molecular arrangement of claimed polymers, therefore, Applicants' elaboration on isotacticity, atacticity and syndiotacticity of ABSOLUTELY IRELEVANT POLYMERS can serve only educational purposes.

Art Unit: 1713

b) Applicants statement on page 7 last paragraph of Paper No. 13, that "although the particular limitations of regarding molecular structure such as tacticity are not claimed , Applicants note that they are entitled to claim physical descriptors of polymers itself". However, first of all the stress and stretch properties are not the properties of polymers, but the films made of these polymers, second, it is reiterated once again that even as presently amended nothing is **changed in terms of the chemical identity and amount of ingredients in a claimed composition.**

As discussed above, the tacticity of polymers is neither claimed nor disclosed or referred to in the instant Specification.

As discussed in the previous and present Office Actions, the chemical identity of a composition and its properties are inseparable. . **In re Spada**, 911 F.2d 705,709,15 USPQ2d 1655,1658 (Fed. Cir. 1990). In alternative the rejection is made under 35 USC 103(a) shifting a burden to Applicants to show how the composition identical to the instantly claimed one can have different physico-mechanical properties, and if there is something in a composition that makes it distinguishable **from the composition** of the prior art, Applicants could have shown it on this record. It is further noted that Applicants themselves admit the identity of compositions as instantly claimed and disclosed by WO'376 (see page 13, line 5 of Paper No. 13).

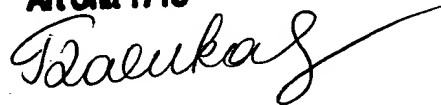
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 305-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

September 12, 2003

**Tatyana Zalukaeva, Ph.D.**  
**Primary Examiner**  
**Art Unit 1713**

A handwritten signature in black ink, appearing to read 'Zalukaeva', with a long horizontal flourish extending to the right.